The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MATS DAHLBACK, MAGNUS LIMBACK
and GUNNAR WILMARK

Appeal 2006-2519
Application 09/857,606
Technology Center 1700

Decided: October 27, 2006

Before PAK, KRATZ, and TIMM, *Administrative Patent Judges.*

KRATZ, *Administrative Patent Judge.*

ORDER REMANDING TO THE EXAMINER

We remand the Application to the Examiner for consideration of the reply brief as a request to reopen the prosecution of the above-identified application consistent with 37 C.F.R. § 41.39(b) (2) (2004) and for reevaluation of the anticipation rejection in light of the recent Federal Circuit decisions cited below.

The record reflects that new grounds of rejection were included in the Examiner's Answer mailed February 14, 2006. *See* Answer 4-6.

37 C.F.R. § 41.39(b) provides that:

> If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:
>
> (1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.
>
> (2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address each new ground of rejection as set forth in § 41.37(c)(1)(vii) and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

On April 14, 2006, Appellants filed a Substitute Appeal Brief (Reply Brief) that was accompanied by additional evidence, including a "new" declaration of Magnus Limback (Exhibit C). The Examiner indicated that

the "Reply Brief" was entered and considered in a Communication mailed on May 24, 2006. In the latter Communication (not identified as a Supplemental Examiner's Answer), the Examiner briefly addressed two declarations (Reply Brief, Exhibits A and B) and noted that Exhibit C was not entered nor considered.

However, there appears to be an inconsistency in the Examiner's treatment of the Reply Brief as a request by Appellants to maintain the appeal and the requirements of the last sentence of 37 C.F.R. § 41.39(b)(2). In this regard, the submission of any additional evidence with the Reply Brief raises the issue of a selection by Appellants of the option to reopen prosecution rather than the option to continue with the appeal in response to the new ground of rejection in accordance with our Regulations. *Id.* Also, see MPEP § 1207.03 (8th ed., Rev. 3, p. 1200-38, August 2005).

Consequently, we remand this Application to the jurisdiction of the Examiner pursuant to our authority under 37 C.F.R. §§ 41.35(b) and 41.50 (a)(1) and order the Examiner to revisit the question of Appellants' selection of the option to reopen prosecution by the submission of new evidence with the Reply Brief. In this regard, we note that a Reply Brief that includes new evidence is not a Reply Brief in compliance with 37 C.F.R. § 41.41, as is required for an election to maintain the appeal under 37 C.F.R. § 41.39(b)(2).

As an additional matter, we note that the Examiner should reconsider the anticipation rejection maintained in the Answer in light of *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1376-77, 77 USPQ2d 1321, 1326-27 (Fed. Cir. 2005) and *Atofina v. Great Lakes Chem. Corp.* 441 F.3d 991, 995, 78 USPQ2d 1417, 1423-24 (Fed. Cir. 2006). In those cases, our

reviewing court addressed anticipation issues that appear to involve applied prior art that disclosed a component that is used in a process, in terms of ranges, as in *Perricone*, or a reactant and a process condition in terms of ranges, as in *Atofina*, as applied to claims that included corresponding narrower and/or overlapping range limitations for those items.[1]

Neither the Examiner nor the Appellants address the recent holdings in the *Perricone* and/or *Atofina* decisions with regard to the issues in the anticipation rejections advanced by the Examiner in this appeal.

Consequently, we also remand this application to the Examiner to review the anticipation rejection in light of the recent *Perricone* and *Atofina* decisions.

Accordingly, the Examiner is required to consider said Reply Brief consistent with current examining practice and procedure, with a view towards advancing the prosecution of this application with respect to the issues presented.

Because a supplemental examiner's answer would not cure the aforementioned inconsistencies in the handling of the new evidence submitted with the Reply Brief as an election by Appellants to reopen the prosecution of this application in response to the new grounds of rejection in the Answer, this Remand is *not* made for the sole purpose of directing the Examiner to further consider the ground(s) of rejection as a part of this appeal. Accordingly, 37 C.F.R. § 41.50(a)(2)(2005) does not apply.

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[1] Also, *see* Section 2131.03 of the most recent edition (Rev. 5, Aug., 2006) of the Manual of Patent Examining Procedure.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center involved, for appropriate action in view of the above comments.

REMANDED

sld

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